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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,668	06/01/2001	Darrel D. Cherry	10008156-1	2901

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HEWLETT-PACKARD COMPANY  
Intellectual Property administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER	
RETTA, YEHDEGA	
ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,668

Applicant(s)

CHERRY ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed December 26, 2005. Claims 1, 9, 10 and 13 have been amended. Claims 1-14 are currently pending.

### ***Claim Rejections - 35 USC § 102***

Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Castle (US2002/0077891).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Castle teaches obtaining a set of user information; obtaining a media request; receiving an electronic copy of the media request (see par. 0009, 0010); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (media on demand); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and

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stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014], [0017]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication). Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010). Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of subscriber's accessing the on-line service.

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Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017).

Regarding claims 2-4, Castle teaches prompting user to input a log-in code; retrieving the code; retrieving user profile; prompting user to register with media selection interface; communicating the profile to at least one advertising provider (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service).

Regarding claims 5-7, Castle teaches locating an advertisement space in said electronic copy, assigning advertisement space, determining the dimension of the advertisement space determining the location of the space and receiving a set of advertisement space information (see par. [0016], [0017], [0021]).

Regarding claim 8, Castle teaches communicating set of user information to said advertising provider at the same the set of advertisement space information is communicated to said advertising provider (see par. [0014] to [0017], [0022] to [0024], [0032]).

Regarding claims 10-12, Castle teaches requiring user to log-in; retrieving the code; retrieving user profile; displaying a list of available media (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service); obtaining a media request; communicating the request to service provider; determining a content provider for (see par. [0009], [0010]); Castle teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (see [0012], [0016], [0017]); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of

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advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014, [0017]]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication). Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010). Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of

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subscriber's accessing the on-line service. Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017).

Regarding claims 13 and 14, Castle teaches a computer having a central processing unit, a memory, and at least one communications port (fig. 2); at least one advertisement database for storing advertisement data and associated user information; a listing of advertisement, a set of dimensions and set of user preference data (see par [0012] to [0016]); operational program for receiving a user information; for querying advertisement database and determining a bid amount (see par. [0012] to [0018]).

Claims 1-14 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Castle further in view of Official Notice.

Regarding claim 9, Castle teaches requiring user to log-in; retrieving the code; retrieving user profile; displaying a list of available media (see [0009], [0010] and [0014] to [0017], which is inherent feature of subscribing to a service); obtaining a media request; communicating the request to service provider; determining a content provider for (see par. [0009], [0010]); Castle

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teaches the Hewlett Packard Instant Delivery service (HPID) using the web to selectively obtain and deliver informational content to recipients; only stories of interest to each subscriber (see [0012], [0016], [0017]); determining a set of advertisement space information from the electronic copy of said media request for at least one advertisement space in the media request (see [0012], [0016], [0017]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored; factor for determining which ads to place in publication ...); communicating said set of advertisement space information to at least one advertising provider to solicit bidding on the advertisement space from the advertisement provider; receiving at least one bid from the advertising provider; comparing the received bids for at least one advertisement space; choosing a winning bid for the space (see par. [0013], [0014], [0017]); querying the advertising provider for an electronic copy of an advertisement for the space and receiving the electronic copy of said advertisement in response to querying the advertising provider for an electronic copy of the advertisement ( see, par. [0017], [0018], [0028], [0029]). Castle teaches electronic copies or versions of advertisements to be placed in an on-line publication are provided or made available to the publisher for placement in the publication and stored. Castle teaches combining said electronic copy of the advertisement with the media request (see par. [0009], [0010]). Castle teaches the HPID uses the web to selectively obtain and deliver informational content to recipients, who subscribe to the HPID service (subscribers) to whom data files, which comprise the publication, are delivered via electronic file transfer. Castle teaches the advertisement of the advertiser offering the highest price is placed in the publication (see par. [0006]). Castle also teaches method to size advertising and content information for



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publication (see par. [0018], [0031], [0032] ) see also (claims 1-37 for placing of the advertisement in the publication). Castle teaches on-line publication services collect publications only stories of interest to subscriber (see 0010). Castle teaches the on-line publication sending advertising to subscribers by using subscriber demographic data. Requiring each registered user to log-in and provide identifying information is inherent feature of subscriber's accessing the on-line service. Subscribers are registered customers. Castle teaches determining advertisement that is targeted to the identified particular user (0014-0017). Castle does not teach that the subscriber is identified by log-in with a magnetic stripe card. Official notice is taken that is old and well known in the art of security system for user to log-in through insertion of smart or magnetic card and/or entry of an identification data or biometric data. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement such feature in the Castle's system for the intended use of providing control access to different security levels.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. The log-in feature as claimed is inherent feature of the accessing on-line service as a subscriber to the service. The claims 1-14 are also rejected under 102(f) and applicant did not provide any argument. The Castle invention and the current application disclose the same invention and it is noted that 35 U.S.C. 101 requires that whoever invents or discovers is the party who may obtain a patent for the particular invention or discovery. 35 U.S.C. 111 (applicant) or 35 U.S.C. 116 (applicants) set forth the requirement that the actual inventor(s) be the party who applies for a patent or that a patent be applied for on behalf of the inventor. Where it can be shown that an applicant has "derived" an invention from

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another, a rejection under 35 U.S.C. 102(f) is proper. The rejection under Double Patenting has been withdrawn.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

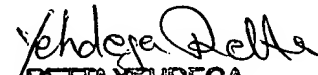
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR

  
**RETIA YEHDEGA**  
**PRIMARY EXAMINER**